

REMARKS**Amendments to the Claims**

Applicant has amended claims 1, 10, 29, 35, 39, 70 and 125-127 to address rejections and/or clerical errors. Applicant contends the amendments are supported by the Specification as filed and thus do not introduce new matter.

Amendment to the Specification

The Examiner objected to page 49 of the Specification for the inclusion of an application serial number which is not commonly owned (08/823,979) and an application which is abandoned (08/823,978), and further requested that a third serial number (08/824,010) be updated to include its current status. Applicant asserts that the incorporation of serial number 08/823,978 is proper in that incorporation of prior filed, commonly owned applications is permissible. *See*, MPEP § 608.01(p)(I)(A)(noting that nonessential subject matter may be incorporated by reference to prior filed, commonly owned U.S. applications and citing *In Re Fouché* for the proposition that abandoned applications can be incorporated by reference to the same extent as copending applications as both types are open to the public upon the referencing application issuing as a patent). Applicant has thus amended the paragraph beginning on page 49, line 15 to include the current status of 08/823,978 and 08/824,010.

Applicant has further amended the paragraph beginning on page 49, line 15 to correct the mis-identification of serial number 08/823,979. Applicant contends that the erroneous identification of serial number 08/823,979 was clearly intended to be directed to serial number 08/823,977 as Applicant had only three copending applications at the time of filing the parent application to the present continuation, with the '977 application being that third application. Further, as Applicant contends that the incorporation is directed to nonessential subject matter, Applicant submits that this correction of a clerical error does not introduce new matter.

Claim Rejections Under 35 U.S.C. § 112

Claims 116-124 and 128-149 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In an effort to advance prosecution on the merits for remaining claims, Applicant has canceled claims 116-124 and 128-151 without prejudice or disclaimer and reserves the right to reintroduce the same or substantially similar subject matter in a continuing application. In view of the cancellation of claims 116-124 and 128-151, Applicant respectfully submits that the rejection under 35 U.S.C. § 112, first paragraph is presently mooted.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3, 9, 10, 29-31, 35, 39-44, 48-58, 60-64, 70-76, 79-87, 89-93, 103-104, 106-111, 113, 125 and 127 were rejected under 35 U.S.C. § 102(b) as being anticipated by Silverman et al. (U.S. Patent No. 5,136,501). Applicant respectfully traverses.

Claims 1, 3, 9 and 10

Claim 1 is amended to recite, in part, “a select one of said digital information blocks can be elected for receipt by one of said second users responsive to said priority indicia.” Applicant contends that the amendment makes clear that a second user can elect a select one of the digital information blocks for receipt. The matching system of Silverman et al. provides for automatic and anonymous matching of transactions and does not purport to permit a user to elect a specific trading instrument. *See*, Silverman, et al., Abstract (“A matching system for trading instruments in which bids are automatically matched against offers . . . comprising means for anonymously matching active bids and offers in the system by trading instrument based on a variable matching criteria . . .”).

The Office Action at page 4 with reference to claim 1 asserts, “Blocks are singled out by a ‘hit bid’ step (col. 9, lines 1-10).” However, Applicant notes that Silverman et al.’s “hit bid” process cannot elect a select one of the digital information blocks as the user initiating the “hit bid” process is not aware of the individual digital information blocks available. Note that the

individual bids and offers of Silverman et al. are held in a central station book (*See*, Silverman et al., Figure 4 and accompanying text), but that the information presented to a user in a keystation book includes only a composite of like bids or offers (*See*, Silverman et al., Figure 5 and accompanying text). In other words, while the central station book may hold multiple bids at a given value with individual quantities, the keystation book will only indicate that a composite quantity is requested at the given bid value. As one example, if there are two offers at a value of 139.19 with quantities of 6.0 and 3.0, respectively, and a bid at a value of 139.19 is entered with a quantity of 10.0, the bid is automatically matched to both offers and executed such that both offers are selected in response to the bid. *See*, Silverman et al., column 17, lines 36-47 (“As is shown by way of example in FIG. 17, there is a bid which has been introduced at the value of 139.19, a value that betters the current best bid. Since there exists no sub-book on this price on the bid side of the book, a new one is created. At this point, the best bid value is equal to the best offer value so the bid and offer sub-books with the value of 139.19 are submitted to the matching function. Assuming that the gross counterparty credit limit is not exceeded, then both of the offer entries are fully traded for a trade total quantity of nine. The bid is only partially traded and a quantity of one remains.”). Thus, Applicant contends that a user of Silverman et al. is incapable of electing a select one of Silverman et al.’s bids or offers for receipt.

In view of the foregoing, Applicant contends that Silverman et al. not only does not teach or suggest an ability to elect a select one of the digital information blocks for receipt, but that it expressly teaches away from this limitation. Applicant thus respectfully submits that claim 1 is patentably distinct from the cited reference. As claims 3, 9 and 10 include all patentable limitations of claim 1, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 1, 3, 9 and 10.

Claims 29-31

Claim 29 is amended to recite, in part, “wherein the singling out of the respective work orders provides for selecting a specific one of the respective work orders in response to a user election for receipt.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability to single out a specific one of its bids or offers in response to

a user election, but instead purports to provide anonymous and automatic matching of compatible active bids and offers. Applicant thus respectfully submits that claim 29 is patentably distinct from the cited reference. As claims 30-31 include all patentable limitations of claim 29, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 29-31.

Claim 35

Claim 35 is amended to recite, in part, “wherein the system is configured in such a manner as to enable any one or more of the service providers to single out and extract a selected one or more of the work orders from the work order database in accordance with selection criteria established by the service providers and the work order package originators.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability for a user to single out and extract a selected one of its bids or offers as it does not present individual bids or offers to its users and instead purports to provide anonymous and automatic matching of compatible active bids and offers. Applicant thus respectfully submits that claim 35 is patentably distinct from the cited reference. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claim 35.

Claims 39-44, 48-58 and 60-64

Claim 39 is amended to recite, in part, “all of the digital information blocks can be selectively singled out for receipt by at least one of the respective users.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability for a user to selectively single out one of its bids or offers as it does not present individual bids or offers to its users and instead purports to provide anonymous and automatic matching of compatible active bids and offers. Applicant thus respectfully submits that claim 39 is patentably distinct from the cited reference. As claims 40-44, 48-58 and 60-64 include all patentable limitations of claim 39, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 39-44, 48-58 and 60-64.

Claims 70-76, 79-87 and 89-93

Claim 70 is amended to recite, in part, “the GUI displays the graphic indicators for all offers to buy and sell and is configured to permit all of the users to visualize the marketplace, any buyer to single out any individual offer to sell, and any seller to single out any individual offer to buy.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability for any buyer to single out any individual offer to sell, and any seller to single out any individual offer to buy, but instead purports to provide only composite bids or offers to its users. Nor does Silverman et al. purport to display graphic indicators for all offers to buy or sell to its users, but instead displays graphic indicators of composite bids and offers.

The Office Action asserts, “The added phrase ‘..to thereby permit any buyer to select any offer to sell and any seller to select any offer to buy.’ are merely recitations of intended usage for the physical interface and carry no patentable weight.” Office Action, page 7, referring to claim 70. Applicant respectfully traverses. Applicant notes that the claim requires the GUI to be configured to permit such selection. This is not an intended use limitation, but a structural limitation of the claimed GUI and it must be given patentable weight. Applicant contends that the system of Silverman et al. is not physically configured to permit such selection and does not, in fact, purport to permit such selection.

In view of the foregoing, Applicant respectfully submits that claim 70 is patentably distinct from the cited reference. As claims 71-76, 79-87 and 89-93 include all patentable limitations of claim 70, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 70-76, 79-87 and 89-93.

Claims 103, 104 and 106

Claim 103 recites, in part, “A buffer memory operated by a first user for storing a plurality of links to respective digital information blocks generated by a plurality of respective second users in an order freely established by the second users” wherein “each of the third users is presented with a link list ordered responsive to the indicia associated with the links stored in

the buffer memory and which link list is configured to permit the user to single out any of the links.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability to permit a user to single out any link associated with an individual bid or offer, but instead purports to provide only composite bids or offers to its users. Applicant thus respectfully submits that claim 103 is patentably distinct from the cited reference. As claims 104 and 106 include all patentable limitations of claim 103, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 103, 104 and 106.

Claims 107-111 and 113

Claim 107 recites, in part, “the GUI configured to permit any of the third users to single out any of the N electronic information blocks” wherein “each of the N electronic information blocks has an associated indicia established by a respective one of M second users.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability for any user to single out a specific one of its bids or offers, but instead purports to provide anonymous and automatic matching of compatible active bids and offers. Furthermore, the blocks of electronic information presented to a user is a composite established by the central system and does not represent an indicia established by an individual user. Applicant thus respectfully submits that claim 107 is patentably distinct from the cited reference. As claims 108-111 and 113 include all patentable limitations of claim 107, these claims are also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 107-111 and 113.

Claims 125 and 127

Claim 125 is amended to recite, in part, “said memory further accessible for reading by each of a plurality of remotely connected second users such that a second user may selectively single out and retrieve at least one of the plurality of digital information blocks in response to that second user’s evaluation of the associated indicia of priority.” As noted with respect to claim 1, Applicant contends that Silverman et al. does not teach or suggest an ability for a user to selectively single out one of its bids or offers, but instead purports to provide anonymous and

automatic matching of compatible active bids and offers such that a single bid or offer may be matched with multiple offers or bids, respectively, without control by the user. Applicant thus respectfully submits that claim 125 is patentably distinct from the cited reference. As claim 127 includes all patentable limitations of claim 125, this claim is also believed to be allowable. Accordingly, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b), and allowance of claims 125 and 127.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 32, 59, 77, 78, 88, 105, 112 and 126

Claims 2, 32, 59, 77, 78, 88, 105, 112 and 126 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverman et al. Applicant respectfully traverses.

Applicant contends that it has shown independent claims 1, 29, 39, 70, 103, 107 and 125 to be patentably distinct over the primary reference of Silverman et al. The taking of official notice fails to overcome the deficiencies of the primary reference. As such, Silverman et al. and the taking of official notice, either alone or in combination, fail to teach or suggest each and every limitation of independent claims 1, 29, 39, 70, 103, 107 and 125. As claims 2, 32, 59, 77, 78, 88, 105, 112 and 126 include all patentable limitations of at least one of these independent claims, these claims are also believed to be allowable. Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 2, 32, 59, 77, 78, 88, 105, 112 and 126.

Claims 59 and 88

Claims 59 and 88 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverman et al. in view of Patterson, Jr. et al. (U.S. Patent No. 5,915,245). Applicant respectfully traverses.

Applicant contends that it has shown independent claims 39 and 70 to be patentably distinct over the primary reference of Silverman et al. The secondary reference of Patterson, Jr. et al. fails to overcome the deficiencies of the primary reference. As such, Silverman et al. and

Patterson, Jr. et al., taken either alone or in combination, fail to teach or suggest each and every limitation of independent claims 39 or 70. As claims 59 and 88 include all patentable limitations of at least one of these independent claims, these claims are also believed to be allowable.

Applicant thus respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and allowance of claims 59 and 88.

CONCLUSION

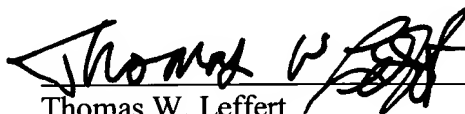
Claims 1, 10, 29, 35, 39, 70 and 125-127 are amended herein. Claims 116-124 and 128-151 are canceled hereby. Claims 1-3, 9, 10, 29-32, 35, 39-44, 48-64, 70-93, 103-113 and 125-127 are now currently pending.

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2204.

Please deem this a petition for extension of time if necessary to maintain pendency of this patent application. Please charge any additional fees necessary to maintain pendency of this patent application or credit any overpayment to Deposit Account No. 501373.

Respectfully submitted,

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